



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,069	02/11/2004	Susan Q. Sanders	50160	2097
22929 7590 04/15/2009 SHAPER ILER LLP 1800 WEST LOOP SOUTH SUITE 1450 HOUSTON, TX 77027				
EXAMINER				
MORRISON, JAY A				
ART UNIT		PAPER NUMBER		
2168				
MAIL DATE		DELIVERY MODE		
04/15/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/776,069

Applicant(s)

SANDERS ET AL.

Examiner

JAY A. MORRISON

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/29/2009 has been entered.

Remarks

1. Claims 1-42 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-11, 13-37, 39 and 41-42 are rejected under 35 U.S.C. 103(a) as being obvious over Pricewatch (www.pricewatch.com, webpages from 1/28/2003) in view of Yahoo (www.yahoo.com, webpages from 12/09/2002) and further in view of Lee et al. ('Lee' hereinafter) ("From Design Features to Financial Performance: A Comprehensive Model of Design Principles for Online Stock Trading Sites", Journal of Electronic Commerce Research, Vol 3, No. 3, 2002).

As per claim 1, Pricewatch teaches

An improved Internet Directory System, comprising: (page 1)

a lower level directory comprehensively referencing viable websites (WSs) relating to a category; (page 2)

the CDWs being identified as Category Directory Websites participating in the System by at least a mark or a URL portion; (page 3)

and a business model imposed on at least the CDWs, including standards of operation. (pages 4-5)

Pricewatch does not explicitly indicate "at least one upper-level Directory Provider (DP), providing a directory organized by at least upper-level fields and/or super-categories and categories, and referencing hundreds of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs) related to the categories" nor "the hundreds of CDWs each providing at least".

However, Yahoo discloses "at least one upper-level Directory Provider (DP), providing a directory organized by at least upper-level fields and/or super-categories and categories, and referencing hundreds of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs) related to the categories" (page 1) and "the hundreds of CDWs each providing at least" (page 1; it would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the plurality shown in Yahoo to include hundreds or thousands, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "at least one upper-level Directory Provider (DP), providing a directory organized by at least upper-level fields and/or super-categories and categories, and referencing hundreds of independently owned (from each other and from the Directory Provider) for-profit

Category Directory Websites (CDWs) related to the categories" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

Neither Pricewatch nor Yahoo "of comprehensiveness and up-to-dateness"

However, Lee discloses "of comprehensiveness and up-to-dateness" (up-to-datedness and indepth analysis, table 1, page 132).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo and Lee because using the steps of "of comprehensiveness and up-to-dateness" would have given those skilled in the art the tools to improve the invention by providing important features on an e-commerce site to attract more business. This gives the user the advantage of being able to keep up with the latest trends and information.

As per claim 2, Pricewatch teaches

The CDWs are identified as participating in the System by a URL portion. (page 5)

As per claim 3, Pricewatch teaches

a standard of operation includes professional management. (page 5)

As per claim 4, Pricewatch teaches

the URL portion includes a TLD. (pages 1-3)

As per claim 5, Pricewatch teaches
a standard of operation includes a comprehensive listing of viable websites
(WSs) related to the category for no charge. (page 4)

As per claim 6, Pricewatch teaches
a standard of operation, imposed on at least a subset of CDWs, includes a CDW
offering web sites at least one of an option to move to a secure site to negotiate a
purchase and an organization of pertinent comparative data on a subject within the
category. (page 3 and 5)

As per claim 7, Pricewatch teaches
the business model includes charging at least some WSs for being referenced.
(page 5)

As per claim 8, Pricewatch teaches
the business model includes at least some WSs being charged for at least one
service offered by a CDW. (page 5)

As per claim 9, Pricewatch teaches

the business model includes a participating CDW providing advertising space on its site. (page 3)

As per claim 10, Pricewatch teaches

the business model includes a CDW promoting, by advertising, at least one of its referenced websites. (page 3)

As per claim 11, Pricewatch teaches

the business model includes at least one advertising/promotion firm that provides advertising/promotion for a category and/or a CDW site substantially in return for advertising space on a CDW site. (page 3)

As per claim 13, Pricewatch teaches

the business model includes substantially funding operation of a CDW by payments from WSs. (page 4-5)

As per claim 14, Pricewatch teaches

the business model includes selection of categories for CDWs large enough to support a Category Directory Website and small enough to be managed according to the business plan. (page 1-2)

As per claim 15,

Pricewatch does not explicitly indicate "the business model includes contracting by at least one DP with a plurality of CDWs to secure a comprehensive listing of CDWs."

However, Yahoo discloses "the business model includes contracting by at least one DP with a plurality of CDWs to secure a comprehensive listing of CDWs." (page 1)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "the business model includes contracting by at least one DP with a plurality of CDWs to secure a comprehensive listing of CDWs" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 16, Pricewatch teaches
the URL portion consists essentially of a TLD. (page 3)

As per claim 17, Pricewatch teaches
the URL portion comprises a TLD unique to CDWs and DPs in the system. (page 3)

As per claim 18, Pricewatch teaches

the business model includes at least website enhancement technology cost effectively offered to appropriate referenced WSS. (page 3)

As per claim 19,

CDW's provide a comprehensive reference to WSS without charge to the WSS.
(page 3-4)

As per claim 20,

Pricewatch does not explicitly indicate "the Directory Provider comprises an ISP or Search Engine."

However, Yahoo teaches "the Directory Provider comprises an ISP or Search Engine." (page 1)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "the Directory Provider comprises an ISP or Search Engine" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 21, Pricewatch teaches

1) the category and 2) at least one field and/or super-category are both more than simply an indicator of city, state, region or nation. (page 3)

As per claim 22, Pricewatch teaches

A method for providing an Internet Directory System, comprising: (page 1)
organizing an independent for-profit directory website to comprehensive
reference viable websites within a category; (page 3)

adopting a URL portion or a mark identifying said directory website as a
participating Category Directory Website; (page 3)
and abiding by a System business model imposed on said Category Directory
Websites including operational standards. (pages 3-4)

Pricewatch does not explicitly indicate "participating in an Internet Directory
System by said directory website by contracting to be referenced as one of hundreds of
Category Directory Websites (CDW) on at least one independent upper-level Directory
Provider's (DP) upper-level directory of at least fields and/or super-categories and
categories, the upper-level directory referencing the CDWs".

However, Yahoo discloses "participating in an Internet Directory System by said
directory website by contracting to be referenced as one of hundreds of Category
Directory Websites (CDW) on at least one independent upper-level Directory Provider's
(DP) upper-level directory of at least fields and/or super-categories and categories, the
upper-level directory referencing the CDWs" (page 1; it would have been obvious to one
having ordinary skill in the art at the time the invention was made to expand the plurality
shown in Yahoo to include hundreds or thousands, since it has been held that the mere

duplication of the essential working parts of a device involves only routine skill in the art (*St. Regis Paper Co. v. Bernis Co.*, 193 USPQ 8)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of “participating in an Internet Directory System by said directory website by contracting to be referenced as one of hundreds of Category Directory Websites (CDW) on at least one independent upper-level Directory Provider’s (DP) upper-level directory of at least fields and/or super-categories and categories, the upper-level directory referencing the CDWs” would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

Neither Pricewatch nor Yahoo “of comprehensiveness and up-to-dateness”

However, Lee discloses “of comprehensiveness and up-to-dateness” (up-to-datedness and indepth analysis, table 1, page 132).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo and Lee because using the steps of “of comprehensiveness and up-to-dateness” would have given those skilled in the art the tools to improve the invention by providing important features on an e-commerce site to attract more business. This gives the user the advantage of being able to keep up with the latest trends and information.

As per claims 23-36,

These claims are respectively rejected on grounds corresponding to the arguments given above for rejected claims 2,16-18,3-5,9-10,20,11,6-7,21 and are similarly rejected.

As per claim 37, Pricewatch teaches the business model includes minimal standards for websites to be included in a directory, for updating website references including adding new websites and for deleting no longer viable websites and standards for certain quality of presentation for participating websites. (page 5)

As per claim 39, Pricewatch teaches the upper level fields and/or super-categories and categories being organized to contain CDWs which pay the DP to be listed in one or more fields, the fee based on a number of web pages hosted or linked to the CDW. (page 5)

As per claim 41, Pricewatch teaches Pricewatch does not explicitly indicate "the hundreds includes thousands". However, Yahoo discloses "the hundreds includes thousands" (page 1; it would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the plurality shown in Yahoo to include hundreds or thousands, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8)).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of “the hundreds includes thousands” would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 42, Pricewatch teaches
the CDWs providing lists of business and/or web pages within their category and organizing those lists into sub-categories. (page 2)

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pricewatch, Yahoo and Lee, and further in view of Morimoto (Publication Number 2002/0013774).

As per claim 12,
Neither Pricewatch, Yahoo nor Lee explicitly indicate “the business model includes offering webpage enhancement services at a volume discount.”

However, Morimoto discloses “the business model includes offering webpage enhancement services at a volume discount” (paragraph [0008]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo, Lee and Morimoto because using the steps of "the business model includes offering webpage enhancement services at a volume discount" would have given those skilled in the art the tools to improve the invention by allowing economies of scale to determine prices. This gives the user the advantage of being able to get better prices if willing to spend more money.

5. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pricewatch, Yahoo, Lee and further in view of eBay (www.ebay.com webpages from 11/15/2002).

As per claim 38,

Pricewatch does not explicitly indicate "the business model includes the CDW being substantially funded through an offer of enhanced listings and value added services, including website enhancement technology where appropriate, to websites, such services tailored to a category and specifically designed to attract and retain viewers".

However, eBay discloses "the business model includes the CDW being substantially funded through an offer of enhanced listings and value added services, including website enhancement technology where appropriate, to websites, such

services tailored to a category and specifically designed to attract and retain viewers" (table 6, listing enhancements).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo, Lee and eBay because using the steps of "the business model includes the CDW being substantially funded through an offer of enhanced listings and value added services, including website enhancement technology where appropriate, to web sites, such services tailored to a category and specifically designed to attract and retain viewers" would have given those skilled in the art the tools to improve the invention by allowing enhancement of listings. This gives the user the advantage of being able to have options to help attract more buyers.

6. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pricewatch, Yahoo, Lee and further in view of Google (www.google.com webpages from 2/22/2002).

As per claim 40,

Pricewatch does not explicitly indicate "the CDWs contracting with an advertising/promotion firm for design, marketing and/or promotional services to be provided at no cost to the CDW while the advertising/promotional firm sells advertising spots on the CDW and collects the revenue generated".

However, Google discloses "the CDWs contracting with an advertising/promotion firm for design, marketing and/or promotional services to be provided at no cost to the CDW while the advertising/promotional firm sells advertising spots on the CDW and collects the revenue generated" (page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo, Lee and Google because using the steps of "the CDWs contracting with an advertising/promotion firm for design, marketing and/or promotional services to be provided at no cost to the CDW while the advertising/promotional firm sells advertising spots on the CDW and collects the revenue generated" would have given those skilled in the art the tools to improve the invention by allowing enhancement of listings. This gives the user the advantage of being able to have options to help attract more buyers.

Response to Arguments

7. Applicant's arguments filed 1/29/2009 have been fully considered but they are not persuasive.

Applicant argues, as a preliminary matter, that the webpages contain dates that show that the content does not come from archived material. Included as evidence that the webpages are in fact archived is the source code from the pages in question. In order to generate the source code listing, the applicant can right-click in the desired

area (the page has different frames) and select "view source" (be sure not to click on a URL or the menu will be different). The bottom of the listing shows the date that the source was archive and was appended by the waybackmachine at the time of archival. In answer to the applicants question of the date on the bottom half of page 2, examination of the source code shows that the browser renders the current date as shown in the following code which is bolded in the included evidence:

```
{min='0'+min}with(buf){document.write('Quotes @'+getHours()+':'+min+' -  
'+(getMonth()+1)+'/'+getDate());}
```

The data which is relied on is static data as is shown in the source code listing and the confusion is simply that the browser rendering the webpages has some embedded functions. The applicant is directed to right-click on any page to "view source" and will see that the prior-art relied upon is in fact archived by the waybackmachine.

Regarding the PriceWatch disclaimer, this is standard legal practice for any legally prudent website. The fact that the information is archived by the waybackmachine attests to its existence as prior art and therefore it is admissible.

Applicant argues that the cited references do not teach comprehensiveness or up-to-datedness, however it is respectfully submitted that the new cited Lee references teaches this limitations and therefore the applicants' arguments regarding this issue are moot in view of the new rejection.

Applicant argues that Yahoo does not teach "hundreds" or "thousands" of CDSs, however it is submitted that it would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the plurality shown in Yahoo to include hundreds or thousands, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art (*St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8).

Applicant argues that the cited references do not teach a directory and that a website cannot be a directory. However, it is respectfully submitted that a directory can be defined as an alphabetical index, which is clearly present in the PriceWatch reference (page 2). Applicant further argues that PriceWatch does not have a business model imposed upon itself, however it is respectfully submitted that PriceWatch has a variety of things that can be considered a model such as allowing the adjustment of prices "any time of day" (page 5) and only allowing "authorized, qualified, computer retailers" to advertise on their site. It is submitted that a business model can be very broadly defined and therefore the cited references do in fact teach these limitations.

Applicant further argues that neither Yahoo nor PriceWatch teach the CDSs being identified as participating in the system by a mark or a URL portion. It is respectfully submitted that that Board of Patent Appeals and Interferences (BPAI) affirmed the examiner on this issue on page 14 of their decision rendered December 10, 2008, and the applicant is directed to that decision.

Applicant further argues that the references teach no system where independent, for-profit category related directory websites are identified by a portion of a URL, in particular a top level domain (TLD). It is respectfully submitted that the various directories within the PriceWatch website are all identified by a portion of the URL of the top level domain (page 2). In other words, the pages are all distinct and all have a common TLD and are all related to a category and therefore these limitations are taught by the cited references.

Applicant further argues that there is not proper motivation to combine the PriceWatch and Yahoo references, however the BPAI decision found that the examiner provided proper motivation for combination of these references and the applicant is directed to page 15 of the BPAI decision rendered December 10, 2008.

Conclusion

8. The prior art made of record, listed on form PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-7112. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jay Morrison/

Jay Morrison
TC2100